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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/761,364

## Applicant(s)

ITO ET AL.

## Examiner

PELING A. SHAW

## Art Unit

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 15-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 01/21/09.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Restriction election***

1. The Office acknowledges the receipt of Applicant's restriction election amendment received on 11/24/2008. Applicant has elected claims 1-14 to be examined.

***Priority***

2. This application claims priority on Japan 2003-057895 dated 03/05/2003, 2003-019298 dated 01/28/2003 and 2003-013137 dated 01/22/2003. The filing date is 01/22/2004.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- a. Claim 1 recites the limitation of "a presence system, comprising: a presence service client ... and a watcher ...; a presence service ...; and a presence calculating part ..., using as a trigger ..." that seems to be of software system nature. It is not a process, machine, manufacture, or composition of matter conforming to 35 U.S.C. 101. Claim 1 and its dependent claims 2 and 7-8 are rejected. For the purpose of applying art, claim 1 is read as of a method claim.
- b. Similarly, claim 3 and its dependent claims 4-6 are rejected. For the purpose of applying art, claim 3 is read as of a method claim.
- c. Claims 9-10 recite the limitation of "a information processing equipment, comprising: a presence service client ... and a watcher ...; a presence service ...; and a presence

calculating part ..., using as a trigger ...; wherein ... further comprises a presence change rule storing part ...” that seems to be of software system nature. It is not a process, machine, manufacture, or composition of matter conforming to 35 U.S.C. 101. Claims 9-10 and their dependent claims 11-12 are rejected. For the purpose of applying art, claims 9-10 are read as of method claim.

- d. Claims 13-14 recites the limitation of “a presence notification controlling program, comprising the capabilities of: making ...” that is of computer software program. It is not a process, machine, manufacture, or composition of matter conforming to 35 U.S.C. 101. Claims 13-14 are rejected. For the purpose of applying art, claims 13-14 are read as of method claim.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-11 and 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by

Lonnfors et al. (US 6757722 B2), hereinafter referred as Lonnfors.

- a. Regarding claim 1, Lonnfors disclosed a presence system, comprising: a presence service client including a presentity that provides presence information and a watcher which observes presence information provided by other presentities than said presentity (column 1, lines 53-65: presentity provide information of its presence, watcher obtain presence information about other users); a presence service which receives presence information from the presentity and delivers the presence information to the watcher (column 1, line 66-column 2, line 16: watcher subscriber presence information); and a presence calculating part which changes the presence information for said presentity on said presence service client (column 8, lines 8-22: partial presence information change), using as a trigger a change in the presence information for other presentities acquired by said watcher on said presence service

- client (column 11, line 60- column 12, line 13: presence information changes, watcher event-trigger).
- b. Regarding claim 2, Lonnfors disclosed the presence system as set forth in claim 1, wherein said presence calculating part has a presence change rule storing part which holds a presence change rule that prescribes how the presence information for said presentity on said presence service client should be changed based on the presence information for said other presentities (column 11, line 60- column 12, line 13: mode, action, sent in desire manner, associated presnec information changes, watcher event-trigger).
- c. Claims 3-4 are of the same scope as claims 1-2. These are rejected for the same reasons as for claims 1-2.
- d. Regarding claim 5, Lonnfors disclosed the presence system as set forth in claim 3, wherein said presentity on said presence service client is a presentity in a group to which said plurality of other presentities observed by said watcher belong (column 1, lines 12-52: instant message, chat session, video conferencing, willing to receive instant message).
- e. Regarding claim 7, Lonnfors disclosed the presence system as set forth in claim 1, wherein said presentity on said presence service client issues own presence to said presence service (column 1, lines 53-65: a presentity provide information as to its presence).
- f. Regarding claim 8, Lonnfors disclosed the presence system as set forth in claim 2, wherein said presentity on said presence service client issues own presence to said

- presence service (column 1, lines 53-65: a presentity provide information as to its presence).
- g. Claim 9 is of the same scope as claims 1-2 and 7. It is rejected for the same reasons as for claims 1-2 and 7.
- h. Claims 10-11 are of the same scope as claims 1-3 and 5. These are rejected for the same reasons as for claims 1-3 and 5.
- i. Claims 13-14 are of the same scope as claims 1 and 3. These are rejected for the same reasons as for claims 1 and 3.

Lonnfors disclosed all limitations of claims 1-5, 7-11 and 13-14. Claims 1-5, 7-11 and 13-14 are rejected under 35 U.S.C. 102(c).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Lonnfors and further in view of Salomaki et al. (WO 02/093959 A1), hereinafter referred as Salomaki.

- a. Lonnfors shows claims 3 and 5 as above. Lonnfors does not show explicitly (claim 6) wherein a group member managing part which adds, modifies or deletes said other presentities belonging to said group is provided. However, Lonnfors does show (Fig. 3, column 8, line 45-column 9, line 38) presence tuple update.

- b. Salomaki shows (pages 37-42) Management of Presence Database, particularly (A.3.12, A.3.13 and A.3.14) for AddPresence, RemovePresence and Dynamice Client Change in an analogous art for the purpose of Mobile Instant Messaging and Presence Service.
- c. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to explicitly specify presence database management functions as per Salomaki in the presence management as per Lonnfors.
- d. The modification would have been obvious because one of ordinary skill in the art would have been motivated to provide database functions as per Salomaki's in the presence management as per Salomaki (page 2, lines 17-28) and Lonnfors (column 3, lines 18-42)'s teaching.
- e. Claim 12 is of the same scope as claims 2-3 and 5-6. It is rejected for the same reasons as for claims 2-3 and 5-6.

Together Lonnfors and Salomaki disclosed all limitations of claims 6 and 12. Claims 6 and 12 are rejected under 35 U.S.C. 103(a).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peling A Shaw/  
Examiner, Art Unit 2444